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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/523,942	02/08/2005	Fred A. Antonini	0771MH-60032-US	8554

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EXAMINER
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CHEVALIER, ALICIA ANN

ART UNIT	PAPER NUMBER
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1794

MAIL DATE	DELIVERY MODE
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12/14/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/523,942	<b>Applicant(s)</b> ANTONINI, FRED A.	
	<b>Examiner</b> Alicia Chevalier	<b>Art Unit</b> 1794	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 September 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-25 and 36-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-25 and 36-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## RESPONSE TO AMENDMENT

1. Claims 1-25 and 36-40 are pending in the application, claims 26-35 have been cancelled.

### ***REJECTIONS***

2. **The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.**

### ***Double Patenting***

3. Claims 1-25 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-6 of copending Application No. 11/072382. Although the conflicting claims are not identical, they are not patentably distinct from each other because they claim the same film.

Application 11/072382 claims a film comprising a dimensionally stable, thin plastic film having a smooth surface finish, and a thin layer of silicone elastomer having a low durometer disposed on a first surface of the plastic film (*claim 1*).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

4. Claims 1-25 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-25 of copending Application No. 10/524367 in view of Braun et al. (U.S. Patent No. 5,300,171).

Application 10/524367 claims a film comprising a dimensionally stable, thin (*claim 2*) plastic film (*claim 24*) having a smooth surface finish, and a thin (*claim 2*) layer of silicone elastomer (*claims 17 and 19*) disposed on a first surface of the plastic film (*claims 1 and 20*).

Application 10/524367 fails to claim that the silicone has a low durometer.

Braun discloses a flexible tape (*title*) made of silicone with a Shore A durometer hardness between 30 and 70 (*col. 4, line 53 through col. 5, line 7*).

Therefore, the exact durometer of the silicone elastomer layer is deemed to be a result effective variable with regard to the flexibility of the article. It would require routine experimentation to determine the optimum value of a result effective variable, such as durometer hardness, in the absence of a showing of criticality in the claimed durometer hardness. *In re Boesch*, 205 USPQ 215 (CCPA 1980), *In re Woodruff*, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990). One of ordinary skill in the art would have been motivated to have a low durometer hardness such as less than 40 on a the Shore A hardness in order to insure flexibility.

This is a provisional obviousness-type double patenting rejection.

### ***Claim Rejections - 35 USC § 103***

5. Claims 1-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kobe et al. (U.S. Patent No. 6,372,323) in view of Braun et al. (U.S. Patent No. 5,300,171) and evidenced by Tokas et al. (U.S. Patent No. 6,960,272).

Regarding Applicant's claims 1 and 3, Kobe discloses a film comprising a plastic film (*additional backing layer, col. 5, lines 26-28 and 51-67*) and a silicone elastomer (*backing layer with stems, col. 5, lines 8-9 and col. 9, lines 48-49*) disposed on a first surface of the plastic film

(figure 1). The plastic film is deemed to be thin (*col. 5, lines 35-36*) and dimensionally stable with a smooth surface, since figure 1 one shows the additional backing is flat, i.e. no texturing/projections, and is used to as a stabilizing layer (*col. 5, lines 26-27*). The silicone elastomer film is deemed to be thin (*col. 5, lines 35-36*). Kobe further discloses that the slip control article is flexible (*col. 1, lines 45-47*).

Kobe fails to disclose that the silicone elastomer has a low durometer, more specifically less than 40 on the Shore A scale.

Braun discloses a flexible tape (*title*) made of silicone with a Shore A durometer hardness between 30 and 70 (*col. 4, line 53 through col. 5, line 7*).

Therefore, the exact durometer of the silicone elastomer layer is deemed to be a result effective variable with regard to the flexibility of the article. It would require routine experimentation to determine the optimum value of a result effective variable, such as durometer hardness, in the absence of a showing of criticality in the claimed durometer hardness. *In re Boesch*, 205 USPQ 215 (CCPA 1980), *In re Woodruff*, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990). One of ordinary skill in the art would have been motivated by the fact that Kobe desires a flexible article to have a low durometer hardness such as less than 40 on a the Shore A hardness in order to insure flexibility.

Regarding Applicant's claim 2, Kobe discloses that the plastic film can be made of thermoplastic elastomers, such as polyolefin (*col. 5, lines 60-61*). Tokas shows that thermoplastic elastomers with polyolefinic material has a low surface energy, such as 28-30 dynes/cm (*col. 2, line 12-22*).

The limitation “co-extruded” is a method limitation and does not determine the patentability of the product, unless the process produces unexpected results. The method of forming the product is not germane to the issue of patentability of the product itself, unless Applicant presents evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. MPEP 2113.

Regarding Applicant’s claim 4, Kobe discloses that the film further comprises an adhesive disposed on a second surface of the plastic film (*col. 5, line 29 and figure 1*).

Regarding Applicant’s claim 5, Kobe discloses that the film further comprises a releasable liner for covering the adhesive prior to use (*col. 5, line 29 and figure 1*).

Regarding Applicant’s claims 6-10, the limitation “polished” is a method limitation and does not determine the patentability of the product, unless the process produces unexpected results. The method of forming the product is not germane to the issue of patentability of the product itself, unless Applicant presents evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. MPEP 2113.

However, the method limitation “polished” does impart structure to the film, which is a flat or non-raised surface. Therefore, Kobe meets the limitation that the silicone elastomer has a polished surface finish, since figures 1 and 8 clearly show non-raised or flat portion on the article. Kobe also meets the limitation the polished surface finish is smooth since figure 1 clearly shows smooth, i.e. flat, portions between the stems. The surface is deemed to be heavily textured (*figure 8*). As seen by figures 8 and 1 the silicone elastomer has textured and polished surface finish.

The limitation “polished surface finish is formed by a casting means having a polished surface finish” is a method limitation and does not determine the patentability of the product, unless the process produces unexpected results. The method of forming the product is not germane to the issue of patentability of the product itself, unless Applicant presents evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. MPEP 2113. Furthermore, there does not appear to be a difference between the prior art structure and the structure resulting from the claimed method because Kobe discloses a surface that is textured and flat.

Regarding Applicant’s claim 11, Kobe discloses that the textured is in an array of upraised dimples (*figures 1 and 8*).

Regarding Applicant’s claim 12, the silicone elastomer is deemed to has a matte finish since is contains projections (*figures 1 and 8*).

Regarding Applicant’s claim 13, the limitation “heat-stabilized” is a method limitation and does not determine the patentability of the product, unless the process produces unexpected results. The method of forming the product is not germane to the issue of patentability of the product itself, unless Applicant presents evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. MPEP 2113.

Regarding Applicant’s claim 14, Kobe discloses that the plastic film has a thickness of about 0.002 inches or less (*col. 5, lines 35-36*).

Regarding Applicant’s claims 15-18, Kobe discloses that the plastic film or silicone elastomer can be tinted with pigments or dyes (*col. 5, lines 62-67*). Therefore, either the plastic

film or silicone elastomer is deemed to comprises a graphical indicia, since either one may can pigments or dyes.

Regarding Applicant's claims 19-24, the limitations "for application on the fingertips of users," "for application on handheld devices," "for placement onto a material handling device," "for use on equipment used in games" and "configured to be sewn into fabric" are deemed to be statements with regard to the intended use and is not further limiting in so far as the structure of the product is concerned. In article claims, a claimed intended use must result in a ***structural difference*** between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. MPEP § 2111.02. Furthermore, it is noted that Kobe's article is useful in golf clubs, baseball bats, household articles, non-slip walking surfaces etc. (*col. 1, lines 60-64*). The intended uses of Kobe's article include Applicant's intended uses for their film.

Regarding Applicant's claims 36-40, Kobe discloses a film comprising a plastic film (*additional backing layer, col. 5, lines 26-28 and 51-67*) and a silicone elastomer (*backing layer with stems, col. 5, lines 8-9 and col. 9, lines 48-49*) disposed on a first surface of the plastic film (*figure 1*). The plastic film is deemed to be thin (*col. 5, lines 35-36*) and dimensionally stable with a smooth surface, since figure 1 one shows the additional backing is flat, i.e. no texturing/projections, and is used to as a stabilizing layer (*col. 5, lines 26-27*). The silicone elastomer film is deemed to be thin (*col. 5, lines 35-36*). Kobe further discloses that the slip control article is flexible (*col. 1, lines 45-47*). The plastic film can be made of thermoplastic elastomers, such as polyolefin (*col. 5, lines 60-61*). Tokas shows that thermoplastic elastomers with polyolefinic material has a low surface energy, such as 28-30 dynes/cm (*col. 2, line 12-22*).



The film further comprises an adhesive disposed on a second surface of the plastic film (*col. 5, line 29 and figure 1*) and a releasable liner for covering the adhesive prior to use (*col. 5, line 29 and figure 1*).

Kobe fails to disclose that the silicone elastomer has a low durometer, more specifically less than 40 on the Shore A scale.

Braun discloses a flexible tape (*title*) made of silicone with a Shore A durometer hardness between 30 and 70 (*col. 4, line 53 through col. 5, line 7*).

Therefore, the exact durometer of the silicone elastomer layer is deemed to be a result effective variable with regard to the flexibility of the article. It would require routine experimentation to determine the optimum value of a result effective variable, such as durometer hardness, in the absence of a showing of criticality in the claimed durometer hardness. *In re Boesch*, 205 USPQ 215 (CCPA 1980), *In re Woodruff*, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990). One of ordinary skill in the art would have been motivated by the fact that Kobe desires a flexible article to have a low durometer hardness such as less than 40 on a the Shore A hardness in order to insure flexibility.

The limitation "heat-stabilized" is a method limitation and does not determine the patentability of the product, unless the process produces unexpected results. The method of forming the product is not germane to the issue of patentability of the product itself, unless Applicant presents evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. MPEP 2113.

***ANSWERS TO APPLICANT'S ARGUMENTS***

6. Applicant's statements noting the provisional double patenting rejections and willingness to take up the issue upon allowance of the present applicant or the applications '382 or '367 are acknowledged and the rejections are maintained.

7. Applicant's arguments in the response filed September 27, 2007 regarding the 35 USC 112, 2<sup>nd</sup> paragraph rejections of record have been considered but are moot since the rejections have been withdrawn.

8. Applicant's arguments in the response filed September 27, 2007 regarding the 35 U.S.C. 103(a) over Kobe in view of Braun and evidenced by Tokas of record have been carefully considered but are deemed unpersuasive.

Applicant argues that one of ordinary skill in the art would not have been motivated to combine Kobe and Braun, because Kobe is concerned with "slip control" and Braun is concerned with "rolling" the material.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, both reference are directed to adhesive articles that desire to be flexible. As Applicant has pointed out Braun discloses a low durometer so that the material can be rolled, in other words Braun desires a low durometer so that the material is flexible enough to be rolled.

Kobe discloses the desire for a flexible article. Therefore, one of ordinary skill in the art would combined Braun and Kobe since Kobe desires flexibility and Braun discloses the durometer range for flexibility for a silicone elastomer.

Applicant argues that claim 2 is separately allowable because it requires the plastic film to have "a surface energy of less than about 40 Dynes/cm." Applicant further points out that there is no motivate to combine Kobe and Tokas.

The examiner is not suggesting to combine Kobe and Tokas. The Examiner is relying on Tokas as evidence that thermoplastic elastomers with polyolefinic materials have a low surface energy, such as 28-30 dynes/cm.

Applicant argues that claim 3 is separately allowable because it requires the silicone elastomer to have "less than 30 on the Shoe A scale." Applicant further points out that Braun teaches a silicon rubber having "a shore A durometer hardness between 30 and 70," which Applicant states is outside the claimed range.

The examiner's agrees that Braun only discloses "a shore A durometer hardness between 30 and 70." However, Applicant has not shown that the claimed durometer hardness is critical and why one of ordinary skill in the art would not have been motivated to optimize the durometer to be less than 40, which includes less than 30, on a the Shore A hardness.

Applicant argues that the limitation "polished" is not a method limitation and that Kobe is silent about a "polished" surface.

Applicant has not provided evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from the prior art. Furthermore, attorney argument is not evidence unless it is an admission, in which case, an examiner may use the

admission in making a rejection. See MPEP § 2129 and § 2144.03 for a discussion of admissions as prior art. The arguments of counsel cannot take the place of evidence in the record. See MPEP § 716.01(c) for examples of attorney statements which are not evidence and which must be supported by an appropriate affidavit or declaration. MPEP 2145.

Applicant's arguments about claim 7 have already been addressed above with regard to the limitation "polished."

Applicant argues that Kobe's projections are not dimples, since a dimple is "an indented, hollowed, or depression area in the surface of something." The examiner disagrees, the spaces between the projections are depression areas, e.g. dimples.

Applicant argues that Kobe doesn't disclose a "matte surface finish." Applicant has not provided evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from the prior art. Furthermore, attorney argument is not evidence unless it is an admission, in which case, an examiner may use the admission in making a rejection. See MPEP § 2129 and § 2144.03 for a discussion of admissions as prior art. The arguments of counsel cannot take the place of evidence in the record. See MPEP § 716.01(c) for examples of attorney statements which are not evidence and which must be supported by an appropriate affidavit or declaration. MPEP 2145.

Applicant's argument regarding the limitation "a heat stabilized plastic film" is moot since it has been addressed in the new grounds of rejection above.

Applicant argues that Kobe does not disclose a "graphical indicia" or a "tint." Applicant has not claimed a specific type of "graphical indicia" or "tint" therefore any pigment or dye that

forms any type of pattern, color, etc. is considered to be a “graphical indicia,” because pigment or dye is a type of artwork.

Applicant argues that “configure for” and “configured to” imparts structural limitations and are not statements with regard to the intended use. The examiner disagrees the phrases “configure for” and “configured to” are not further limitation with respect the structure, however the prior art structure must be capable of so performing in such a manor. It is clear that since Kobe’s article is useful on golf clubs and base ball bats that is can be configured for application on the fingertips of the user since the users fingertips will grip the club or bat and a bat and club is a handheld device and a material handling device.

### *Conclusion*

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Chevalier whose telephone number is (571) 272-1490. The examiner can normally be reached on Monday through Friday from 8:00 am to 4:00 pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye, can be reached on (571) 272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

Application/Control Number:  
10/523,942  
Art Unit: 1794

Page 13

system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
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6/29/04

   
**ALICIA CHEVALIER**  
**PRIMARY EXAMINER**